



Docket No.: KSM-0228/CIP  
(PATENT)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Patent Application of:  
Shinjiro Ogita et al.

Application No.: 10/521,244

Confirmation No.: 7196

Filed: January 14, 2005

Art Unit: N/A

For: PROCESS FOR PRODUCING A  
DECAFFEINATED COFFEE PLANT BY  
GENETIC RECOMBINATION

Examiner: Not Yet Assigned

**REPLY TO NOTIFICATION OF DEFECTIVE RESPONSE**

MS PCT  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

**INTRODUCTORY COMMENTS**

This Reply is in response to the Notification of Defective Response mailed on October 25, 2005. A copy of the Notification of Defective Response is provided along with this Reply as ATTACHMENT A.

**Background**

Japanese Patent Application No. 2002-207221 has a filing date of July 16, 2002. Within one year (1) or twelve months (12) from the filing date of the Japanese Patent Application, International Application No. PCT/JP2003/009008 was filed with the International Searching Authority on July 16, 2003. The International Application claims the benefit of the filing date of the Japanese Patent Application.

Within thirty months (30) from the filing date of the International Application, the application papers for the present U.S. application (Application No. 10/521,244) were deposited with the Patent and Trademark Office (USPTO) on January 14, 2005. The application papers

were deposited along with A Transmittal Letter to the United States Designated/Elected Office (DO/EO/US) Concerning a Submission Under 35 U.S.C. 371.

The deposited application papers further include a specification of twenty-one (21) pages. Within the originally-filed specification is a description found on pages 1-18, claims 1-4 found on pages 19-20, and an Abstract found on page 21. The deposited application papers additionally include three (3) sheets of drawings having figures 1-3.

A Notification of Missing Requirements Under 35 U.S.C. 371 in the United States Designated/Elected Office (DO/EO/US) was mailed on August 3, 2005. The Notification of Missing Requirements contends that the current translation of the application into English is defective. In addition, the Notification of Missing Requirements includes a request for an Oath or Declaration of the inventors.

As a reply to the Notification of Missing Requirements, a Response to Notification of Missing Requirements was filed on August 18, 2005. An executed Declaration of the inventors requested by the Notification of Missing Requirements was provided on August 18, 2005 along with the Response.

Thereafter, the Notification of Defective Response was mailed on October 25, 2005.

### **Argument**

Pursuant to the practice and procedures in the USPTO, if there are any conflicting instructions as to whether the filing is under 35 U.S.C. §111(a) or 35 U.S.C. §371, the application will be accepted as filed under 35 U.S.C. §111(a). M.P.E.P. §1893(a).

Claims 1-4 are found on pages 19-20 of the specification as originally filed. The Notification of Defective Response of October 25, 2005 notes that the translation of the application into English is defective because the number of claims in the International Application and the number of claims in the translation are not the same.

In addition, page 1 of the specification as originally filed provides that this application is a continuation-in-part application of International Application PCT/JP2003/009008 (not published in English) filed July 16, 2003.

Moreover, the executed Declaration of the inventors filed on August 18, 2005 includes a claim for the benefit under 35 U.S.C. §120 of International Application PCT/JP2003/009008. International Application PCT/JP2003/009008 was pending on January 14, 2005 when the application papers for the present U.S. application were deposited in the USPTO.

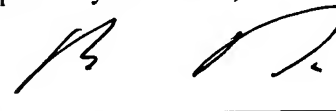
**Relief**

In view of the above, it is respectfully requested that the above-identified application be accepted as an application under 35 U.S.C. §111(a), and that the above-identified application be accorded with a filing date of January 14, 2005.

If any fee is required or any overpayment made, the Commissioner is hereby authorized to charge the fee or credit the overpayment to Deposit Account # 18-0013.

Dated: November 23, 2005

Respectfully submitted,

By 

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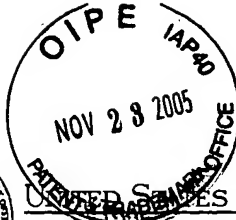
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ATTACHMENT A

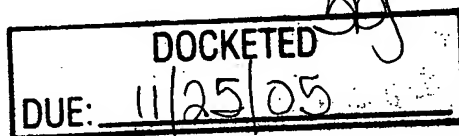


UNITED STATES PATENT AND TRADEMARK OFFICE

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 United States Patent and Trademark Office  
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U.S. APPLICATION NUMBER NO.	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
10/521,244	Shinjiro Ogita	KSM-0228

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INTERNATIONAL APPLICATION NO.	
PCT/JP03/09008	
I.A. FILING DATE	PRIORITY DATE
07/16/2003	07/16/2002

CONFIRMATION NO. 7196

371 FORMALITIES LETTER



\*OC000000017315311\*

DTN: 85013-0228  
 Date Mailed: 10/25/2005

DUE: 11/25/05

## NOTIFICATION OF DEFECTIVE RESPONSE

The following items have been submitted by the applicant or the IB to the United States Patent and Trademark Office as a Designated / Elected Office (37 CFR 1.495)

- Priority Document
- Copy of the International Application filed on 01/14/2005
- English Translation of the IA filed on 08/18/2005
- Copy of the International Search Report filed on 01/14/2005
- Preliminary Amendments filed on 01/14/2005
- Information Disclosure Statements filed on 01/14/2005
- Oath or Declaration filed on 08/18/2005
- Request for Immediate Examination filed on 01/14/2005
- U.S. Basic National Fees filed on 01/14/2005
- Assignment filed on 08/18/2005
- Priority Documents filed on 01/14/2005

Applicant's response filed 08/18/2005 is hereby acknowledged. The following requirements set forth in the NOTIFICATION of MISSING REQUIREMENTS mailed 08/03/2005 have not been completed.

The following items **MUST** be furnished within the period set forth below in order to complete the requirements for acceptance under 35 U.S.C. 371:

- Translation of the application into English. The current translation of the application into English is defective as described below. Note a processing fee will be required if submitted later than 30 months from the priority date.
  - The number of claims in the International Application and the number of claims in the translation are not the same.

## SUMMARY OF FEES DUE:

Total additional fees required for this application is \$-860 for a Large Entity:

RECEIVED

Applicant is required to complete the response within a time limit of ONE MONTH from the date of this Notification or within the time remaining in the response set forth in the Notification of Missing Requirements, whichever is the longer. No extension of this time limit may be granted under 37 CFR 1.136, but the period for response set in the Notification of Missing Requirements may be extended under 37 CFR 1.136(a).

(A previous payment of \$860 will be applied to the additional fees indicated above.)

Applicant is reminded that any communications to the United States Patent and Trademark Office must be mailed to the address given in the heading and include the U.S. application no. shown above (37 CFR 1.5)

*A copy of this notice **MUST** be returned with the response.*

ANITA D JOHNSON

Telephone: (703) 308-9140 EXT 226

PART 1 - ATTORNEY/APPLICANT COPY

U.S. APPLICATION NUMBER NO.	INTERNATIONAL APPLICATION NO.	ATTY. DOCKET NO.
10/521,244	PCT/JP03/09008	KSM-0228

FORM PCT/DO/EO/916 (371 Formalities Notice)